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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRAMIL S.R.L. (ESAPHARMA),]
Petitioner,]
v.] Cancellation No. 92032341
MICHEL FARAH,]
Registrant.]
_____]

BRIEF FOR THE PETITIONER, PRAMIL S.R.L.

Donald L. Dennison
Dennison, Schultz, Dougherty & Macdonald
Attorneys for Petitioner
1727 King Street
Suite 105
Alexandria, VA 22314
(703)837-9600 Exten. 15

March 1, 2005

LAW OFFICES
DENNISON, SCHULTZ, DOUGHERTY & MACDONALD
SUITE 105
1727 KING STREET
ALEXANDRIA, VIRGINIA 22314-2700
703 837-9600



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TABLE OF CONTENTS

	PAGE
Table of Cases, Statutes and Authorities.....	iii
Background of the Case.....	1
Petitioner's Evidence.....	2
Registrant's Evidence.....	2
Issues to be Decided by the Board.....	3
Petitioner's Mark and it's Use.....	3
Likelihood of Confusion.....	6
Summary.....	7
Certificate of Service.....	8

TABLE OF CASES, STATUTES AND AUTHORITIES

CASES:

Page

The Coca-Cola Company v. Clay 139 USPQ 308 (CCPA 1963)...6

Levi Strauss & Co. v. R. Josephs Sportswear, Inc.
28 USPQ2d 1464 (TTAB 1993).....7

Omega SA v. Compucorp 229 USPQ 191,195 (TTAB 1985).....7

Plus Products v. Plus Discount Foods, Inc.
218 USPQ 726 (CA 2, 1983).....7

STATUTES:

TBMP §704.03(a).....7

TBMP §704.04.....7

37 C.F.R. §2.122(b)(2).....7

BACKGROUND OF THE CASE

On May 1, 2001, Michel Farah, hereinafter Registrant, was granted Registration No. 2,447,970 covering the trademark **OMIC PLUS** as applied to cosmetics, namely body cream, body oil, skin cream, skin and body lotions, skin moisturizer, skin lightener, skin soap, skin toners, soaps for hands, face and body, in both liquid and solid form in Class 3.

The registration matured from an application based upon alleged use of the mark in commerce of November 1990 and the application was filed on May 30, 2000. (Ser. No. 76/058,821).

The Petitioner is an Italian Joint Stock Company, having an office near Milan, Italy, and is a leading manufacturer and distributor of pharmaceutical products and cosmetics of various types including a wide range of skin care products which are identical to or similar to those specified in the registration here sought to be cancelled.

The evidence produced by the Petitioner shows that Opposer manufactured in Italy, or elsewhere, a variety of cosmetic products under its **OMIC** mark and exported these products to its United States distributor I.C.E. Marketing

Inc. or its predecessors at least as early as May 13, 1994, long prior to the filing of the application of Registrant.

Use of the mark on cosmetic products has continued uninterrupted to date.

All of Petitioner's goods exported to the United States under its **OMIC** trademark have been prominently and clearly labeled with the trademark in manners common in the trade.

Accordingly, it is believed by the Petitioner that there is a very high likelihood of confusion as to the source of said goods and damage to the Petitioner has will undoubtedly result if the alleged mark were to be allowed to exist on the federal register.

PETITIONER'S EVIDENCE

The evidence submitted by the Petitioner, Pramil S.R.L. (ESAPHARMA), consists of the trial deposition transcript of the deposition of Jacob Aini, and copies of sixteen exhibits introduced at the deposition by the Petitioner. All of these exhibits were properly identified by the witness, made of record at that time and copies submitted to the Board.

REGISTRANT'S EVIDENCE

The Registrant has taken no testimony in this case, nor has any evidence or documentary material been submitted, save

for a single exhibit introduced during cross-examination of Mr. Aini, noted supra. It should be noted that Registrant has sought and obtained extensions of three full months to take its trial testimony, but has failed to do so.

ISSUES TO BE DECIDED BY THE BOARD

Priority of use is the dominant issue in this case. It is clear that the marks of the two parties are nearly identical, the only difference being the additional word, "PLUS", which the Registrant appends to its trademark **OMIC**. It is clear that the goods of the parties are also identical or very similar and are sold to the same class of customers. The only other possible issue in this case is an objection raised by Registrant's counsel to the introduction of Petitioner's Exhibits. On page 44, lines 15-17 of the Aini transcript, an objection on the ground of hearsay was interposed. This may be raised by the Registrant.

PETITIONER'S MARK AND IT'S USE

The Petitioner is a manufacturer and marketer of a wide variety of cosmetic and pharmaceutical products sold worldwide from its headquarters near Milan, Italy. It's sales in the United States are directed through its exclusive agent,

Michael Aini, of I.C.E. Marketing, Inc. of Maspeth, New York.

(Aini p.5, line 18-25, and p. 7, lines 12-19)

Mr. Aini testified that he was familiar with a line of products under the **OMIC** brand that were produced by the Petitioner and shipped to different countries including the United States since 1994. (Aini p. 6, line 19 through p.8, line 19). The formulation of the **OMIC** products varies from country to country, based upon the needs and the laws of the particular country. (Aini p. 8, line 11 through p. 9, line 11)

The **OMIC** product of the Petitioner comes in a variety of forms, including a cream, a gel, a soap and a lotion. (Aini p 13, lines 6-9) The product is a cosmetic cream, gel or soap that serves as a facial moisturizer and removes some blemishes. It is purely a cosmetic and not a pharmaceutical. (Aini p. 14, lines 6-8, 13, and 14)

At one time, Mr. Aini owned a company by the name of Zuri International. (Aini p16, lines 23 through p. 17, line 9) This company had a distributor under the name of Tex International located in Miami, FL. (Aini p. 17, lines 10-14) As can be seen in Petitioner's Exhibit 1, an invoice for \$160,000 was prepared on May 13, representing the shipment of six thousand units of "**OMIC** gel plus". (Aini p. 18, lines 7-23) This was a product imported by Zuri from the Petitioner. (Aini p. 19, lines 3-5). Mr. Aini was familiar with this

shipment and the invoice was in his custody and taken from his records. (Aini p20, lines 5-10)

Additional invoices of June 14, 1995 and February 8, 1996 (Petitioner's Exhibits 2 and 3) attest to continued shipments of **OMIC** gel to customers in the United States.

Due to improper use of the **OMIC** mark in the United States and elsewhere by the Registrant, the Petitioner prepared a document on October 25, 2000 for distribution to the trade advising that they "didn't authorize for Michel Farah or any party in partnership with him to produce or distribute any of our products in the U.S.A..." **OMIC PLUS** was specifically mentioned in the document. (Petitioner's Exhibit 6)

Sales of the **OMIC** product by the Petitioner have continued uninterrupted to date and sales never ceased nor was the brand ever abandoned. (Aini p. 29, lines 7-13). Additionally samples of invoices extending to the summer of 2004, just prior to the Aini testimony deposition have been introduced. See Petitioner's Exhibits 7 through 12 and 15.

Within the State of Florida alone, sales for the two years 2003 and 2004 totaled about \$40,000. (Petitioners Exhibit 15 and Aini p. 43 line 3 through p. 44, line 10)

Petitioners lightening cream sold under the **OMIC** brand is packaged in a yellow and white box bearing the name of the Petitioner and the mark with the word PLUS. (Petitioner's

Exhibit 13). An example of packaging for **OMIC** soap is shown in the box forming Petitioner's Exhibit 14.

Petitioner has not engaged in extensive advertising, but has presented its product at trade shows in the United States at the Javitz Center and in Las Vegas. (Aini p. 13, lines 21-24)

LIKELIHOOD OF CONFUSION

There should be no doubts in this case as to the existence of a likelihood of confusion in the marketplace. The tests to be applied by the Board in determining the rights of the two parties is likelihood of confusion, mistake, or deception. *The Coca-Cola Company v. Clay* 139 USPQ 308 (CCPA 1963). The presence or absence of likelihood of confusion is usually determined by a consideration of the relationship between the parties' goods and the similarities of their respective marks.

In this case, the goods are identical, although their quality and selling price are unknown when compared to each other, since nothing can be found in the record regarding Registrant's commercial activities, if any.

The conditions under which the goods of the two parties are encountered by the public and under what purchasing conditions should also be given consideration in the

evaluation of the likelihood of confusion issue. We are not dealing here with the "sophisticated consumer", but rather the impulse buyers who typically shop the aisles or store displays and then select products such as cosmetics, soaps, creams and gels. *Plus Products v. Plus Discount Foods, Inc.* 218 USPQ 726 (CA 2, 1983).

Petitioner has established on the record actual use of the mark **OMIC** in commerce in the United States at least as early as May 1994, with continued use to date, such first use being prior to the filing date of Registrant's application, May 30, 2000, which absent any evidence, is the earliest date upon which the Registrant can rely. Registrant cannot rely on its alleged date of first use set forth in its registration without the submission of competent properly adduced evidence introduced during the testimony period. TBMP §704.03(a) and §704.04, 37 C.F.R. §2.122(b)(2). *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.* 28 USPQ2d 1464 (TTAB 1993). Also see *Omega SA v. Compucorp* 229 USPQ 191,195 (TTAB 1985).

Accordingly, priority issues should be resolved in favor of the Petitioner.

SUMMARY

Petitioner has fully met its burden of proof of a likelihood of confusion between the marks of the parties which

are identical and the goods which are the same. Further, the Petitioner has clear priority based upon the submitted evidence. All of the factors noted above serve to the Petitioner's position and the Registration should be cancelled.

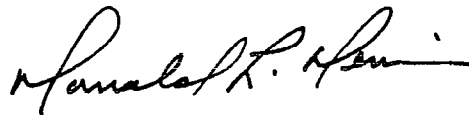
Respectfully submitted,



Donald L. Dennison
Attorney for Petitioner
Dennison, Schultz, Dougherty
& Macdonald
1727 King Street
Suite 105
Alexandria, VA 22314
(703)837-9600 Ext. 15

CERTIFICATE OF SERVICE

This is to certify that a copy of Petitioner's Brief and Request for Oral Hearing were served by the undersigned upon counsel for the Registrant, David M. Rogero, Esq., 2600 Douglas Road, Suite 600, Coral Gables, FL 33134, by first class mail, proper postage affixed, this 2nd day of March, 2005.



Donald L. Dennison

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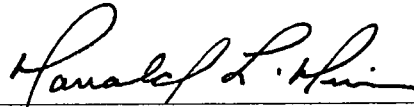
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Registrant.]	
]	

REQUEST FOR ORAL HEARING

An oral hearing is requested in the above-identified
Opposition in accordance with 37 CFR §2.129(a).

Respectfully Submitted,
PRAMIL S.R.L. (ESPHARMA)

By: _____



Donald L. Dennison
Dennison, Schultz, Dougherty
& Macdonald
Attorneys for Petitioner
1727 King Street
Suite 105
Alexandria, VA 22314
(703) 837-9600 Ext. 15